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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,718	06/25/2001	Dale W. Malik	BELL-0105/01031	2081
38952	7590	11/17/2004	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			NGUYEN, QUANG N	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,718

Applicant(s)

MALIK, DALE W.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ☐
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Detail Action***

1. This Office Action is in response to the Application SN 09/888,718 filed on 06/25/2001. Claims 1-20 are presented for examination.

***Claim Objections***

2. Claim 20 is objected to because of the following informalities:

Claim 20, line1: please replace "method" by --system--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**4. Claims 1, 7 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenstein (US 6,266,692).**

5. As to claims 1 and 7, Greenstein teaches a method for blocking all unwanted email using a header-based password, comprising:

receiving an email (*IPS receives advertisement emails from an advertiser as in steps 102-104*) (Greenstein, Fig. 1 and C3: L39-42);

identifying whether the email has a vendor registration code (*i.e., passcode*) for identifying a vendor from whom the email was forwarded (*ISP email server checks passcodes of all received emails as in step 106*) (Greenstein, Fig. 1 and C3: L42-44);

if the email has a vendor registration code, presenting the email with other emails having vendor registration codes (*if the email has a valid passcode, the email server approves the email at step 108 and sends the email to the user's mail inbox at step 110*) (Greenstein, Fig. 1 and C3: L46-49).

6. Claim 16 is a corresponding claim of method claim 1; therefore, it is rejected under the same rationale.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claim 8-12, 15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Paul (US 5,999,932).**

9. As to claims 8 and 15, Paul teaches a system and method for filtering unsolicited emails, comprising:

receiving an email (step 401 of Fig. 4A);

if the email is from the source that is identified in a contact list (*i.e., an inclusion list*), presenting the email with other emails received from sources identified in the contact list (*steps 404, 410 and 415 of Fig. 4A*); and

if the email is from the source that is registered to forward emails (*i.e., a source that matches one of acceptable addresses/domains in the inclusion list*), presenting the email with other emails received from sources registered to forward emails (*i.e., placing the message in a folder based on its status such as "OK" or other modes that are known in the art*) (Paul, C7: L52-62 and C9: L7-47).

10. As to claims 9-10, Paul teaches the method of claim 8, further comprising:

if the email is not from a source that is identified in a contact list and not from a source that is registered to forward emails, presenting the email with other emails that are not from a source that is identified in a contact list and not from a source that is registered to forward emails (*i.e., placing the message in a folder on its status as "NEW" or "JUNK", i.e., not "OK"*) (Paul, C9: L7-47).

11. As to claim 11, Paul teaches the method of claim 9, further comprising parsing the email to identify at least one of the following: a user name from whom the email was forwarded; a source from which the email was forwarded; a vendor registration code; and a vendor registration purpose code (*upon receipt of an email message, the email filter retrieves data from the "FROM" field of the received email, i.e., identifying a username/source from whom/which the email was forwarded*) (Paul, C8: L17-27).

12. As to claim 12, Paul teaches the method of claim 11, further comprising comparing the username and source to the contact list to determine if the email is from a source that is identified in the contact list (*upon receipt of an email message, the email filter retrieves data from the "FROM" field of the received email and compares the field data retrieved from the received message with data stored in the corresponding category of the inclusion list*) (Paul, C8: L17-27).

13. Claims 18-20 are corresponding system claims of method claims 8-10; therefore, they are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**15. Claims 2-3, 13-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein, in view of Schiavone et al. (US 2002/0120702), herein after referred as Schiavone.**

16. As to claims 2-3, Greenstein teaches the method of claim 1, but does not explicitly teach identifying whether the email has a vendor registration purpose code for identifying the purpose of the email and presenting the email with other emails having the same vendor registration code and vendor registration purpose code.

In a related art, Schiavone teaches a system and method for categorization and categorized display of messages in a recipient's inbox which is divided into sections acting like multiple inboxes, each section displaying messages falling in a certain corresponding category ([0048]), wherein the new email message is associated with a category ([0050]) by reading of a message identifier from header information of the new email message ([0051]) and determining whether the message identifier matches the category identifier ([0055]) (Schiavone, Figs. 6-7 and [0048 – 0051 and 0054-0055]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Greenstein and Schiavone to identify the purpose of the email and presenting the email with other emails having the same vendor registration code and vendor registration purpose code since such methods were conventionally employed in the art to enhance the efficacy of the email messaging and counteracts dilution caused by receipt of numerous, unimportant email messages by segregating mail into meaningful categories (Schiavone, [0048]).

17. Claims 13-14 contain corresponding limitations as ones in claims 1-2; therefore, they are rejected under the same rationale.

18. Claim 17 contains corresponding limitations as ones in claims 2-3; therefore, it is rejected under the same rationale.



**19. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein, in view of Paul (US 5,999,932).**

20. As to claims 4-5, Greenstein teaches the method of claim 1, but does not explicitly teach identifying whether the username and source of the email message identify a valid contact.

In a related art, Paul teaches a system and method for filtering unsolicited emails generating and storing a user inclusion list including identification data (*such as list of valid/approved email addresses or groups of email addresses organized by domain*) for identifying email desired by the user, wherein upon receipt of an email message, the email filter retrieves data from selected fields (*such as FROM, TO, CC, etc.*) of the received email message and compares the retrieved data with data stored in the corresponding category of the user inclusion list (*i.e., identifying whether the username and source identify a valid contact*) (Paul, C7: L52-62 and C8: L17-31).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Greenstein and Paul to check whether the username and source of the email message identify a valid contact since such methods were conventionally employed in the art to sort out email messages by comparing one or more predetermined data fields (*such as username and domain*) of each email message with data stored in an automatically updated database of acceptable addresses and domains (*inclusion lists*) to determine if email messages are of potential interest to the user or just "junk" or "spam" email messages.

21. As to claim 6, Greenstein-Paul teaches the method of claim 5, further comprising identifying a source category corresponding to the source identified for the email (*i.e., identifying the "FROM" field has a domain that matches one of a pre-defined list of domains that assured to be junk-free such as corporations or government organizations*) (Paul, C9: L34-45).

22. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

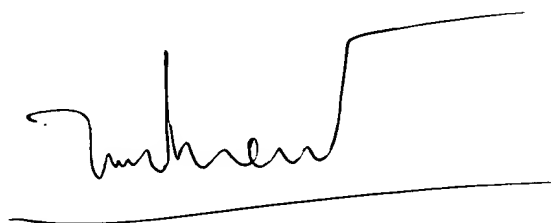
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23. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Le Hien Luu', is written over a horizontal line.

LE HIEN LUU  
PRIMARY EXAMINER